

REMARKS

In the Office Action mailed November 2, 2007, the Examiner objected to the application as follows:

- The Information Disclosure Statement (“IDS”) filed October 16, 2003, was objected to for allegedly failing to comply with 37 C.F.R. § 1.98(a)(2).
- The drawings were objected to for various informalities.

Also in the Office Action, the Examiner rejected claims 1-17 as follows:

- Claims 1, 3-7, and 10 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over U.S. Patent No. 5,932,336 (the “Allen patent”), in view of U.S. Patent No. 6,748,677 to Briant (the “Briant patent”), and in further view of U.S. Patent No. 5,869,591 to McKay et al. (the “McKay patent”).
- Claims 8 and 9 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Briant patent, in further view of the McKay patent, and in further view of U.S. Patent No. 5,771,605 to Safdie (the “Safdie patent”).
- Claims 11-15 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Briant patent, and in further view of the McKay patent.
- Claims 16 and 17 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Briant patent, in further view of the McKay patent, and in further view of the Safdie patent.

Applicants respectfully request reconsideration of this application in view of the foregoing amendments to the specification and claims and the following comments.

I. The Objection to the Information Disclosure Statement

As mentioned above, the Examiner objected to IDS filed October 16, 2003, for allegedly failing to comply with 37 C.F.R. § 1.98(a)(2). More specifically, the Examiner requested legible copies of the non-patent literature publications cited in the IDS.

In response, Applicants submit with this Amendment legible copies of the four non-patent literature publications that were previously cited in the IDS. The objection to the IDS should now be withdrawn.

II. Repeated Objections to the Figures

The Examiner again objected to drawings because (1) reference numerals 100 and 110 do not appear in Figure 7; and (2) reference numeral 104 does not appear in Figure 8.

In the previous Amendment, Applicants removed reference numerals 100 and 110 from paragraph [0055] of the published application, thereby removing any suggestion that these reference numerals are shown in Figure 7. In addition, Applicants previously amended paragraph [0058] of the published application to clarify that reference numeral 104 is shown in Figure 4.

In response, the Examiner maintained the objections stating, "[w]hile Applicant has amended paragraphs 55 and 58, paragraphs 30 and 33 have not been amended." However, previously amended paragraphs [0055] and [0058] in the published application correspond to paragraphs 30 and 33 in the patent application. For this reason, the Examiner's objections to the drawings should now be withdrawn.

III. New Objection to the Figures

The Examiner further objected to the drawings because (1) reference numerals 106 and 108 do not appear in Figures 1 or 4; and (2) reference numeral 122 does not appear in Figure 4.

In response to the first rejection, Applicants have removed reference numerals 106 and 108 from paragraphs [0050] and [0053] of the published application (i.e., paragraphs 25 and 28 of the patent application).

In response to the second rejection, the Applicants have amended paragraph [0058] of the published application (i.e., paragraph 33 of the patent application) to clarify that reference numeral 104 is not shown in Figure 8.

For these reasons, the Examiner's new objections to the drawings should now be withdrawn.

IV. The § 103(a) Rejection of Claims 1, 3-7, and 10 Based on the Allen Patent in View of the Briant and McKay Patents

As mentioned above, independent claim 1 and its dependent claims 3-7, and 10 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Briant patent, and in further view of the McKay patent.

Independent claim 1, and its dependent claims 3-7, and 10, generally define an article of footwear including an upper and a sole, wherein the sole has an outsole for directly contacting a ground surface, and further including at least one element compression molded with the outsole. The at least one element is formed from a first material comprising at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber. In addition, the outsole includes a second material that is compatible for compression molding with the at least one element. This second material is less hard and less dense than the first material. Applicants have now amended independent claim 1 to add the limitation that the element has the specific performance property of showing no damage during a bending test performed at 23°C W. Prick or at -10°C Prick. This limitation is described in paragraph [023] of the application, as filed.

The Allen patent discloses a golf shoe incorporating a spike socket spine frame system embedded in the outsole and extending throughout the shoe sole, for receiving all of the spike receptacles. The spine frame is made of a material that is stiffer than the outsole material, but that material lacks any ethylene vinyl acetate. In fact, the Allen patent fails to disclose the use of any material comprising ethylene vinyl acetate and certainly any material having a composition of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber. In addition, the Allen patent describes a method in which a

hard frame piece of preferably TPU is first injection molded and then placed into a second mold where the cup sole is then injection molded about the spine. Thus, not only does the Allen patent fail to disclose the use of any material comprising the required ethylene vinyl acetate material, but it even teaches away from Applicants' invention in which the outsole and additional element are compression molded together.

In the Office Action, the Examiner asserted that, because the outsole and the frame coexist in the same final product of the Allen patent, they must be compatible for compression molding. Applicants question this assertion and respectfully request the Examiner to provide support for the assertion, given their understanding that the conditions of time, temperature and pressure utilized in compression molding are often very different from those used in injection molding. In addition, the Allen patent fails to disclose that the outsole is less dense than the frame; rather, it discloses only that the outsole is "softer" than the frame. It does not necessarily follow that a softer material is less dense.

The Briant patent fails to make up for these deficiencies of the Allen patent.. The Briant patent discloses a sole having at least one stud that can be releasably mounted within a receptacle by inserting a fastening projection of the stud into the receptacle. The fastening projection includes a first locking member, and the receptacle includes a flexible wall having a second locking member. The flexible wall is deflected when the fastening projection is inserted into the receptacle until the first and the second locking members engage. As noted by the Examiner, the Briant patent teaches that "the various components of the detachable cleat system can be manufactured from any suitable polymeric material or combination of polymeric materials . . . Suitable materials include: . . . ethylene vinyl acetate (EVA) . . ."

However, Applicants note that the Briant patent fails to disclose the use of any material having a specific composition of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer and approximately 20% synthetic rubber and further having the specific performance property of showing no damage during a bending test performed at 23°C W. Prick or at -10°C Prick.. Further, the Briant patent fails to disclose Applicants' claimed requirement that the outsole material be less hard and less dense than the ESS material used to form the element.

The McKay patent, likewise, fails to make up for these deficiencies. The McKay patent discloses blends of a specific pseudorandom or substantially random interpolymers of an ethylenic monomer and a vinylidene aromatic monomer, such as styrene, having a unique comonomer distribution, which can only be accomplished by the use of the specific metallocene catalysts and processes disclosed in columns 9-11. However the McKay patent, with its generic reference to "any combination thereof," fails to disclose Applicants' specific composition of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber, and further having the specific critical performance property of showing no damage during a bending test performed at 23°C W. Prick or at -10°C Prick.

For this reason, the obviousness rejection of claims 1, 3-7, and 10 is improper and should be withdrawn.

V. The § 103(a) Rejection of Claims 8 and 9 Based on the Allen Patent in View of the Briant, McKay, and Safdie Patents

As mentioned above, dependent claims 8 and 9 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Briant patent, in further view of the McKay patent, and in further view of the Safdie patent.

Claims 8 and 9 depend from independent claim 1. Applicants incorporate the arguments made above regarding the Allen, Briant and McKay patents. The deficiencies of these patents are not remedied by the Safdie patent, which fails to disclose or even suggest an element of an article of footwear having the claimed specific composition of at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber, and further having the specific performance property of not showing damage during a bending test performed at 23°C W. Prick or at -10°C Prick.

Moreover, the Safdie patent fails to disclose or suggest an element of an article of footwear having an electroplated member that is visible on the sole, as required by claim 9. Moreover, these deficiencies are not cured by the Allen, Briant, and McKay patents.

For these reasons, the obviousness rejection of dependent claims 8 and 9 is improper and should be withdrawn.

**VI. § 103(a) Rejection of Claims 11-15 Based on the Allen Patent
In View of the Briant Patent, and in further view of the McKay Patent**

As mentioned above, independent claim 11, and its dependent claims 12-15, were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent in view of the Briant patent, and in further view of the McKay patent.

Independent claim 11, and its dependent claims 12-15, generally define an article of footwear having an upper and a sole, wherein the sole has an outsole for directly contacting a ground surface, at least one element compression molded with the outsole, and at least one cleat receptacle compression molded with the at least one element and accessible for attachment of a non-metal cleat. The at least one element is formed from a first material comprising at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer, and approximately 20% synthetic rubber. In addition, the outsole is defined to include a second material that is compatible for compression molding with the at least one element. This second material is less hard and less dense than the first material. Applicants have also amend independent claim 11 to specify that the element has the specific performance property of showing no damage during a bending test performed at 23°C W. Prick or at -10°C Prick. This feature is described in paragraph [023] of the application, as filed.

For the reasons set forth above with respect to independent claim 1, the Allen, Briant, and McKay patents fail to disclose such an article of footwear. The obviousness rejection of claims 11-15, therefore, is improper and should be withdrawn.

**VII. § 103(a) Rejection of Claims 16 and 17 Based on the Allen Patent
In View of the Briant, McKay, and Safdie Patents**

As mentioned above, dependent claims 16 and 17 were rejected under 35 U.S.C. § 103(a), as allegedly obvious over the Allen patent, in view of the Briant patent, in further view of the McKay patent, and in further view of the Safdie patent.

Claims 16 and 17 depend from independent claim 11. For the reasons set forth above, the Allen, Briant, McKay, and Safdie patents fail to disclose the claimed invention. The obviousness rejection of claims 16 and 17, therefore, is improper and should be withdrawn.

VIII. Conclusion

The foregoing remarks should place this application in condition for allowance. No new matter has been introduced by the foregoing amendments. If any matters remain outstanding after consideration of this Amendment that the Examiner believes might be expedited by a telephone conference with Applicants' representative, he is respectfully requested to call the undersigned attorney at the telephone number indicated below. As indicated in the transmittal form filed herewith, please charge any fees due in connection with this filing to our Deposit Account No. 19-1853.

Respectfully submitted,

SHEPPARD, MULLIN, RICHTER & HAMPTON LLP

By: _____


James R. Brueggemann
Registration No. 28,286

Sheppard, Mullin, Richter & Hampton LLP
333 South Hope Street, 48th Floor
Los Angeles, California 90071
Telephone: (213) 620-1780 x4156
Facsimile: (213) 620-1398